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May 13, 2004

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PATENTIN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:	Patent Application of Jean-Pierre Molitor, <i>et al.</i>	: Group Art Unit: 1651 : : :
Appln. No.:	09/980,192	: Examiner: Irene Marx : :
Filed:	April 15, 2002	: Confirmation No.: 1128 : :
For:	FERMENTATION MEDIUMS AND PROCESSES USING THE SAME	: Attorney Docket : No.: H 4156 PCT/US

RESPONSE TO RESTRICTION REQUIREMENT

This is in response to the Office Action dated February 13, 2004 ("the Office Action"), in the above-identified application. This response is being timely filed as a Petition for a two-month extension of time, up to and including May 13, 2004, including an authorization to charge fees, is being submitted herewith.

Applicants respectfully request reconsideration of the Examiner's Requirement for Restriction, in light of the following remarks.

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REMARKS

Claims 11-32 are currently pending in the present application.

Election Requirement

In the Office Action, the Examiner has required the election of a single invention for prosecution on the merits. The Examiner contends that the application contains claims directed to two inventions "which are not so linked as to form a single general inventive concept under PCT Rule 13.1," and thus, lack unity of invention. (*See*, the Office Action, p. 2).

The Examiner has identified the inventions to which the election requirement applies, as follows:

Group I, claim(s) 11-20, drawn to a fermentation medium; and

Group II, claim(s) 21-32, drawn to a method of fermentation.

The Examiner argues that these inventions, "do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

No common inventive concept is shared among groups I through II since a technical relationship is lacking among the claimed inventions involving one or more special technical features because the reaction medium and method of use thereof in fermentation are known in the art."

(*See*, the Office Action, p. 2).

Although, without explicitly stating as much, the Examiner argues that since a single cited reference identified by the Examiner allegedly discloses "the reaction medium and method of use thereof", that the two inventions cannot share a special technical feature.

On the basis of the foregoing arguments and contentions, the Examiner has required the election of a single invention from among Groups I and II.

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Traversal of the Restriction Requirement

Applicants strenuously, but respectfully, traverse the election requirement for the following reasons.

To begin with, Unity of Invention practice alone, not ordinary restriction practice under 35 U.S.C. §121, applies in the instant application which is a national stage U.S. application based upon an International application. Section 1893.03(d) of the M.P.E.P., 7th Edition, Revision 1, clearly explains 37 C.F.R. §§ 1.475 & 1.499, which govern Unity of Invention during the national stage, as follows: “[w]hen making a lack of unity of invention requirement, the examiner must (1) list the different groups of *claims* and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.” (See, M.P.E.P. §1893.03(d), *(emphasis added)*).

The Examiner has identified two specific groups of claims. However, Applicants submit that the Examiner has failed to satisfy the second requirement. While the Examiner has summarily alleged that the two groups are not so linked as to form a single general inventive concept, the Examiner’s arguments and contentions in support of this conclusion are inadequate and fail to properly address the necessary lack of a single general inventive concept. In fact, the Examiner’s purported basis for lack of a special technical feature underscores Applicants’ argument against restriction. In other words, since the Examiner was able to find a single reference which is alleged discloses both claimed inventions it is clear that no restriction is necessary. While Applicants expressly disagree as to any such anticipatory or obviating effect of the reference’s disclosure, it is clear that the Examiner was able to search both inventions simultaneously without any undue burden.

Applicants respectfully submit that all of the pending claims relate to a single general inventive *concept* under PCT Rule 13.1, namely reaction mediums for fermentation which comprise microemulsions of particular components and which have specific average droplet sizes, and the use thereof. Pursuant to PCT Rule 13.2, the Examiner must consider each invention as a whole with respect to “special technical features”. PCT Rule 13.2 states that,

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[w]here a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. (Patent Cooperation Treaty, Rule 13.2).

In terms of addressing Unity of Invention, the question is not whether the special technical feature actually makes a contribution over the prior art, but rather whether each group of claims contains the same technical feature(s) upon which the patentable contribution over the art is to be judged. If the Examiner is of the opinion that both groups are unpatentable, then the Examiner should reject both groups accordingly, but as discussed above, both groups can clearly be examined simultaneously.

Applicants respectfully submit that each of the claimed inventions has a common special technical feature. Therefore, the inventions relate to a single general inventive concept. Applicants also respectfully note that the PCT authorized officer who handled the instant application during the international stage did not have an objection based upon unity of invention.

Therefore, Applicants respectfully submit that the election requirement of a single disclosed invention for prosecution on the merits is improper, and further request reconsideration by the Examiner, withdrawal of the election requirement, and concurrent prosecution on the merits of all pending claims.

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Provisional Election With Traverse

In the event the Examiner does not find Applicants' arguments with respect to the withdrawal of the election requirement persuasive, and the Examiner maintains the election requirement set forth in the Office Action, Applicants provisionally elect the invention identified by the Examiner as Group I, claim(s) 11-20, with traverse, for prosecution on the merits.

Respectfully submitted,

JEAN-PIERRE MOLITOR, et al.

May 12, 2004
(Date)

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